



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/749,597	12/28/2000	Ravi Ganesan	3350-42-A	4821

7590 12/14/2004
ANTONELLI, TERRY, STOUT & KRAUS, LLP
1300 NORTH SEVENTEENTH STREET
SUITE 1800
ARLINGTON, VA 22209

EXAMINER


SNAPP, SANDRA S

ART UNIT PAPER NUMBER

3624

DATE MAILED: 12/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/749,597	Applicant(s) GANESAN ET AL.	
	Examiner Sandra Snapp	Art Unit 3624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 December 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 May 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>12-18-03</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Information Disclosure Statement

The information disclosure statement (IDS) submitted on 12-18-03 was filed in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement has been considered by the examiner.

Drawings

The drawings are objected to because they are informal and some of the lettering is not legible making it difficult to read. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the

Art Unit: 3624

applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 101

Claims 1-7 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 1-7 are directed to non-statutory subject matter because they lack any recitation of technology in the body of the claims, which is required in order to meet the statutory requirements. The Patent Office had taken the position that some form of technology must be claimed in the body of the claim. The Board of Patent Appeals and Interferences has stated that claims lacking any technology are “nothing more than [an] abstract idea which is not tied to any technological art and is not a useful art as contemplated by the Constitution.” *Ex parte Bowman*, 61 USPQ2d 1669, 1671 (Bd. Pat. App. & Inter. 2001) (Unpublished). While it is understood that the Bowman case is not precedential, it is cited herein for its content and reasoning. The Examiner suggests amending claims 1-7 to include some form of technology such as a computer, to overcome this rejection.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Art Unit: 3624

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1-22 are rejected under 35 U.S.C. 102(e) as being anticipated by the Randle et al. patent (US 6,594,647 B1).

The Randle reference discloses a method, associated system, and article of manufacture for making payments via a network, comprising:

Receiving, by a payment service provider,

information identifying a network user (col. 7, lines 15-26),

information identifying a payment account associated with the network user (col.

7, lines 15-26), and

a payment request to execute a payment on behalf of the network user (col. 7, lines 15-26),

the network user being previously unknown to the payment service provider (col. 7, lines 15-26),

Art Unit: 3624

processing the received information identifying the network user and the received information identifying the payment account to verify the received information (col. 7, lines 31-55),

processing the received information identifying the network user and the received information identifying the payment account to generate a unique user identifier associated with the network user (col. 7, lines 15-26),

storing the received information identifying the network user and the received information identifying the payment account in association with the generated unique user identifier (col. 4, lines 49-56), and

if the received information is verified, directing a debit from the identified payment account associated with the network user to execute the payment without the network user transmitting the unique user identifier to the payment service provider (col. 3, line 66 through col. 4, line 3),

a first network station (col. 7, line 67 through col. 8, line 20),

a second network station (col. 7, line 67 through col. 8, line 20),

a computer readable medium (inherent in computer network system that stores information – record archive, col. 4, lines 49-56),

a computer programming stored on the medium (inherent in computer network system that stores information – record archive, col. 4, lines 49-56) (Claims 1, 8 and 16);

transmitting, by the payment service provider, if the received information is verified, the unique user identifier (col. 7, lines 55-65), and

Art Unit: 3624

transmitting, by the payment service provider, a notice of one of (1) verification of the received information and acceptance of the payment request for execution, and (2) non-verification of the received information and non-acceptance of the payment request for execution (col. 7, lines 55-65) (Claims 2, 9 and 17);

the information identifying the network user, the information identifying the payment account, and the payment request are received during an on-line communication session (col. 5, lines 35-57),

the notice is transmitted during the on-line communication session (col. 7, lines 55-65), and

the unique user identifier, if transmitted by the payment service provider, is transmitted during the on-line communication session (col. 7, lines 55-65) (Claims 3, 10 and 18);

the unique user identifier, if transmitted by the payment service provider, is transmitted with the notice of verification of the received information and acceptance of the payment request for execution (col. 7, lines 55-65) (Claims 4, 11 and 19);

the unique user identifier, if transmitted by the payment service provider, is transmitted at one of (1) a time prior to directing the debit, and (2) a time subsequent to directing the debit (col. 10, lines 62-67) (Claims 5, 12 and 20);

the information identifying the network user, the information identifying the payment account, and the payment request are received from one of (1) the network user, and (2) a sponsor which maintains a Web site with which the network user is associated (col. 7, lines 32-65), and

Art Unit: 3624

the notice is transmitted to at least one of (1) the network user, and (2) the sponsor (col. 7, lines 32-65) (Claims 6, 13 and 21);

the unique user identifier is an account number used to identify the network user to the payment service provider (col. 7, lines 55-65) (Claims 7, 15 and 22); and

a third network station, wherein the first network station is associated with a sponsor which maintains a Web site with which the network user is associated (col. 7, lines 6-8 and col. 7, line 67 through col. 8, line 20),

wherein the third network station is associated with the network user (col. 7, lines 6-8),
and

wherein the second network station is further configured to transmit the notice to the third network station (col. 7, line 67 through col. 8, line 20) (Claim 14).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The Pieterse, Pollin, Ishikawa, O'Leary, Gross, Bissonette, McKeen, Johnson, Cotton, Polk and Landry references are all directed to various types of electronic payment systems.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sandra Snapp whose telephone number is 703-305-6940. The examiner can normally be reached on Mon.-Thurs.

Art Unit: 3624

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on 703-308-1065. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SS

Sandra S. Snapp
SANDRA S. SNAPP
PATENT EXAMINER
GROUP 3600